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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,489	10/07/2003	Mie Yoshino	243661US2CONT	4038
22850	7590	09/01/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, HOAN H	
			ART UNIT 2852	PAPER NUMBER

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,489

Applicant(s)

YOSHINO, MIE

Examiner

Hoan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/754,061.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/07/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The response time for this application has been restarted since the new claims 16-33 had been overlooked in the previously sent non-final rejection, new non-final rejection for claims 1-33 is provided below:

Specification

1. The abstract of the disclosure is objected to because there is a typographical error in line 4; e.g., "or" needs to be corrected as --of--. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities:
 - Page 6, line 25, replace "20" with --20d--.
 - Page 7, line 4, replace "20d" with --20b--.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,636,716 to Yoshino.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the subject application, noted supra, are essentially verbatim the claims of U.S. Patent No. 6,636,716 to Yoshino except for the fact that base claims 1, 5, 11 and 13, respectively, add the recitation or limitation that the roller portion has a surface potential substantially equal to a bias for development while base claims 3 and 8, respectively, of U.S. Patent No. 6,636,716 to Yoshino further recite that the roller portion has a ten-point mean surface roughness so as to reduce irregularities on a surface of the development liquid on the roller portion. Accordingly, it is submitted that the claims of the subject application are not patentably distinct from the subject matter being claimed in the commonly owned patent to Yoshino and that issuance of a second patent would provide an unjustified extension of the term to the right to exclude granted by a patent. See Eli Lilly & Co. v Barr Labs, Inc., 251 F.3d 955, 58 USPQ 2d 1865 (Fed. Cir. 2001)

Regarding claims 16-33, the claimed method steps are inherent from the product structure.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 3, 8, 20, 21, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Iino et al. ['148]

Iino et al., an applicant's disclosed prior art, disclose a liquid developing unit [20] comprising a developing roller [202], which includes a roller portion contacting an image carrier [1] and rotatable while carrying a developing liquid including a carrier liquid and a developing substance [Fig. 3; Col. 4, line 21 to Col. 5, line 41]; wherein the outer surface of the developing roller having a ten-point means roughness of less than 5 μ m [Col. 9, lines 28-29].

Regarding claims 20, 21, 29 and 33 the claimed method steps are inherent from the product structure.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iino et al. in view of Nakashima et al. ['034]

Iino et al., as discussed above, disclose the claimed invention except for the image carrier having a surface formed of a-Si.

Nakashima et al. disclose an image forming apparatus comprising an image carrier having a surface formed of a-Si [Col. 26, line 10].

It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to provide the image carrier disclosed by Iino et al. with a surface formed of a-Si as taught by Nakashima et al. for the purpose of ensure a stable supply of developing liquid to the image carrier.

Regarding claim 33 the claimed method steps are inherent from the product structure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoan H. Tran whose telephone number is (571) 272-2141. The examiner can normally be reached from 8:30 AM - 5:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Arthur Grimley can be reached at (571) 272-2136. The central office fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read "Hoan Tran". The signature is written in a cursive, flowing style.

HHT
August 24, 2004

**HOAN TRAN
PRIMARY EXAMINER**